

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ANDREAS SCHABERT and GUNTHER SCHULTZ

Appeal No. 2002-1052
Application No. 09/205,250

HEARD AUGUST 13, 2002

Before ABRAMS, MCQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application. Claims 1-8 and 10-14 were amended subsequent to the final rejection to delete reference numerals and to change

BACKGROUND

The appellants' invention relates to "a recloseable dustproof pack with tamperproof seal which consists of cardboard, paperboard or a similar material and can be formed and filled mechanically" (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief. Independent claim 1 is illustrative of the invention and reads as follows:

1. Reclosable dustproof pack with tamperproof seal, which is intended for packaging low-thickness products and is formed from cardboard or paperboard, consisting essentially of a front side wall and rear side wall which are substantially rectangular and have substantially the same dimensions, the front side wall and the rear side wall being arranged so as to be located one above the other, on a total of three sides the respective edge regions are adhesively bonded to one another by having an adhesive coating applied over their surfaces, and the front side wall and the rear side wall are connected to one another on the non-adhesively-bonded side via a folding line, this resulting in a sealed pocket for low-thickness products which is closed off towards the outside, the front side wall being provided with a flap which is articulated on the front side wall by means of a second folding line and which is otherwise joined to the surrounding region of the front side wall by means of weakening lines, said flap providing the only access to said pocket without breaking said adhesive bonds or causing destruction to said pack so that a product stored in said pocket cannot be removed therefrom without detection.

De Woskin	3,486,615	Dec. 30, 1969
Hadick	3,773,251	Nov. 20, 1973
Murata	4,666,040	May 19, 1987
Etheredge, III et al. (Etheredge)	5,133,477	Jul. 28, 1992
Davidson et al. (Davidson)	5,133,496	Jul. 28, 1992
Cartmell et al. (Cartmell)	5,695,456	Dec. 9, 1997

The following rejections are before us for review.

Claims 1-15 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that appellants, at the time the application was filed, had possession of the claimed invention.

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as follows¹:

claims 1, 2 and 5 as being unpatentable over Hadick;

claims 1, 2, 5 and 6 as being unpatentable over Davidson;

claim 4 as being unpatentable over Hadick in view of Heuberger;

claim 4 as being unpatentable over Davidson in view of Heuberger;

claims 6 and 7 as being unpatentable over Hadick in view of one of Murata and Etheredge;

claims 6 and 7 as being unpatentable over Davidson in view of one of Murata and Etheredge;

claim 8 as being unpatentable over Hadick in view of De Woskin;

claim 8 as being unpatentable over Davidson in view of De Woskin;

claims 3 and 11 as being unpatentable over Hadick in view of Cartmell;

claims 3 and 11 as being unpatentable over Davidson in view of Cartmell;

claim 10 as being unpatentable over Hadick in view of Cartmell and Heuberger;

claim 10 as being unpatentable over Davidson in view of Cartmell and Heuberger;

claims 12 and 13 as being unpatentable over Hadick in view of Cartmell and one of Murata and Etheredge;

claims 12 and 13 as being unpatentable over Davidson in view of Cartmell and one of Murata and Etheredge;

claim 14 as being unpatentable over Hadick in view of Cartmell and Kaplan;

claim 14 as being unpatentable over Davidson in view of Cartmell and Kaplan;

claim 9 as being unpatentable over Hadick

claim 9 as being unpatentable over Hadick in view of one of Murata and

claim 15 as being unpatentable over Hadick in view of Cartmell;
claim 15 as being unpatentable over Davidson in view of Cartmell;
claim 15 as being unpatentable over Hadick in view of Cartmell and one of
Murata and Etheredge; and
claim 15 as being unpatentable over Davidson in view of Cartmell and one of
Murata and Etheredge.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 24) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 23) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Based on our review, for the reasons which follow, we have determined that none of the examiner's

The examiner's position in rejecting claims 1-15 under the first paragraph of 35

U.S.C. § 112 is set forth on pages 6-7 of the answer as follows:

Claims 1-15 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While being enabling for a structure as shown, it does not reasonably provide original enablement for the claimed structure being delimited by "consisting essentially of", as its meaning is judicially considered. See MPEP 2111.03. When an applicant contends that additional structure in the prior art is excluded by the recitation of "consisting essentially of", applicant has the burden of showing that the addition of additional structure would materially change the characteristics of applicant's invention. See *In re De Lajarte*, 143 USPQ 256 (CCPA 1964) and *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-1064 (BPAI 1989).

The "consisting essentially of" transitional phrase was intended to distinguish chemical and methodology where additional components or steps render an entirely different structure. In simple mechanical structures such as applicants', it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

We share appellants' justifiable confusion, as expressed on pages 3-4 of the brief, as to whether the examiner's rejection is based on the written description

specification meets both requirements of 35 U.S.C. § 112. As for the role of the phrase “consisting essentially of” in distinguishing over the prior art, this issue has no relevance to the requirements of 35 U.S.C. § 112, first paragraph.

Insofar as the enablement requirement is concerned, the dispositive issue is whether appellants’ disclosure, considering the level of ordinary skill in the art as of the date of appellants’ application, would have enabled a person of such skill to make and use appellants’ invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of appellants’ disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

As clearly illustrated in Figures 1, 2, 5 and 6, appellants’ original disclosure provides support for a reclosable pack which includes only a front side wall 1 and a rear side wall 2 connected to one another by a folding line 3 and adhered to one another on a total of only three sides of the edge regions thereof, the front wall being provided with a flap 11, as recited in claim 1, which provides the only access to the pocket without breaking the adhesive bonds. It is quite apparent from appellants’ disclosure that the breaking of the adhesive bonds or the tearing of the weakening lines 12-14 to open the

adhesive is provided on all four sides of the edge regions of the front and side walls and the front and rear side walls are not connected to one another by a folding line.

For the foregoing reasons, we are satisfied that one skilled in the art would be able from appellants' disclosure to make and use a reclosable dustproof pack consisting essentially of the elements recited in either claim 1 or claim 3, without undue experimentation. Thus, we shall not sustain the examiner's rejection of claims 1-15 under the first paragraph of 35 U.S.C. § 112 based on lack of enablement.

We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217

the reclosable dustproof pack consisting essentially of the elements recited in either claim 1 or claim 3. Thus, we shall also not sustain the examiner's rejection of claims 1-15 under the first paragraph of 35 U.S.C. § 112 on the basis that the subject matter now claimed is not supported by appellants' original disclosure (i.e., failure to satisfy the written description requirement).

In summary, the examiner's rejection under 35 U.S.C. § 112, first paragraph is not sustained.

The prior art rejections

We note, at the outset, that neither the examiner's rejection of claim 1 as being unpatentable over Hadick nor the examiner's rejection of claim 1 as being unpatentable over Davidson includes any of elements (B), (C) and (D) set forth in § 706.02(j) of the MPEP to establish a prima facie case of obviousness. Specifically, the examiner does not set forth the differences between the claimed subject matter and the applied reference, the proposed modification necessary to arrive at the claimed subject matter or an explanation as to why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

In any event, as aptly pointed out by appellants on page 11 of their brief, a card

tamperproof seal such that a product stored therein cannot be removed therefrom without detection, as called for in claim 1.

In the examiner's response to appellants' arguments on page 16 of the answer, the examiner contends that removal of the slot 16 and its function as an after-formation filling means would have been obvious and would result in a tamperproof structure. We do not agree. Without the slot 16, it would be impossible to insert an item into the mail carrier device after it has been assembled, thereby rendering the mail carrier unsuitable for its intended purpose. It thus would not have been obvious to one of ordinary skill in the art to remove the slot 16 as proposed by the examiner². Accordingly, we shall not sustain the examiner's rejection of claim 1, or claims 2 and 5 which depend therefrom, as being unpatentable over Hadick.

Davidson also fails to teach or suggest the subject matter of claim 1, in that Davidson's combination greeting card and pouch includes three panels 12, 14 and 16, with panels 12 and 14 and 14 and 16, respectively, connected by folding lines. As such, Davidson does not disclose a pack consisting essentially of a front side wall and a rear side wall as called for in claim 1. The panels 12 and 16 of Davidson which are adhesively bonded to one another to form a sealed pocket "closed off towards the

Rather, each of panels 12 and 16 is connected to the middle panel 14 via a separate folding line. In short, there are no two panels or walls which meet all of the requirements of the front side wall and rear side wall recited in claim 1. While the examiner broadly asserts that the “omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art” (answer, pages 8-9), the examiner does not specify which element or elements are proposed to be omitted to arrive at the invention or explain why one of ordinary skill in the art would have been motivated to make such a modification to Davidson. Finding no teaching or suggestion to omit an element of Davidson’s structure to arrive at appellants’ invention when left to our own devices, we shall not sustain the examiner’s rejection of claim 1, or claims 2, 5 and 6 which depend therefrom, as being unpatentable over Davidson.

We have reviewed the teachings of the additional references applied in the rejections of claims 4 and 6-8 which depend from claim 1 and find nothing therein to overcome the above-noted deficiencies of Hadick and Davidson. Thus, we also shall not sustain the rejections of claim 4 as being unpatentable over Hadick in view of Heuberger and over Davidson in view of Heuberger, the rejections of claims 6 and 7 as

unpatentable over Hadick in view of De Woskin and over Davidson in view of De Woskin.

Claim 3 is substantially similar to claim 1, with the exception that claim 3 recites that the front and rear side walls are adhesively bonded to one another on all four sides of their respective edge regions. The examiner concedes that neither Hadick nor Davidson discloses a pack having front and rear side walls adhered to each other on all four sides of their edge regions. To overcome this deficiency, the examiner relies on Cartmell, which discloses a wound packing package 20 which includes peripherally (i.e., all four sides) sealed first and second sheets 22, 24, the sheets being sealed by a bead of adhesive 26 on one or both sheets (column 5, lines 22-23 and 34-38). As pointed out by appellants on page 18 of their brief, however, the examiner has not explained why one of ordinary skill in the art would have found any suggestion in Cartmell to form the mail carrier device of Hadick or the greeting card/gift pouch of Davidson with separate blanks or walls adhered to one another on all four sides.

The examiner's statement on page 19 of the answer to the effect that the blank of either Hadick or Davidson "can be broken down along its individual sidewalls or panel zones into integrally joined elements and would not provide any new result over the

Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In any event, as also pointed out by appellants on page 17 of their brief, even if Cartmell were combined with either Hadick or Davidson as proposed by the examiner, this would still not overcome the above-noted deficiencies of Hadick and Davidson. For the foregoing reasons, we shall not sustain the rejections of claim 3, or claim 11 which depends from claim 11, as being unpatentable over Hadick in view of Cartmell and over Davidson in view of Cartmell.

None of the additional references applied in the rejections of claims 10 and 12-14 which depend from claim 3 overcome the above-noted deficiencies of the combinations of Hadick and Cartmell and Davidson and Cartmell. Thus, we also shall not sustain the rejections of claim 10 as being unpatentable over Hadick in view of Cartmell and Heuberger and over Davidson in view of Cartmell and Heuberger, claims

Etheredge, and claim 14 as being unpatentable over Hadick in view of Cartmell and Kaplan and over Davidson in view of Cartmell and Kaplan.

Claims 9 and 15 are directed to methods for dustproof, tamperproof and resealable packaging of plasters comprising packaging the plasters in the pack of claim 1 and claim 3, respectively. Inasmuch as we have determined, supra, that neither Hadick nor Davidson teaches or suggests the pack of claim 1 or claim 3 and that the additional teachings of Murata, Etheredge and Cartmell do not make up for the deficiencies of Hadick and Davidson in this regard, we shall not sustain the examiner's rejections of claim 9 as being unpatentable over Hadick, over Hadick in view of one of Murata and Etheredge and over Davidson in view of one of Murata and Etheredge or the rejections of claim 15 as being unpatentable over Hadick in view of Cartmell, over Davidson in view of Cartmell, over Hadick in view of Cartmell and one of Murata and Etheredge and over Davidson in view of Cartmell and one of Murata and Etheredge.

CONCLUSION



To summarize, the decision of the examiner to reject claims 1-15 under 35
U.S.C. § 112, first paragraph and 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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